

REMARKS

I. Amendments to the Specification

The specification is amended to refer to prior applications, and to correct clerical and typographical errors.

The application as published does not contain an amendment to the specification that was submitted concurrently with filing during entry of International Patent Application No. PCT/US2004/042147 under 35 U.S.C. §371. The amendment is a reference to the International Patent Application. Applicants hereby re-submit this amendment and request entry thereof.

Paragraph [0114] is amended to correct a clerical error in the spelling of tetrazolyl- α -amino-3-hydroxy-5-methyl-4-isoxazolepropionic acid. Applicants submit that the error is obvious to one of ordinary skill in the art, who would have been able to readily recognize the error in the specification as presented. Applicants further submit that the skilled artisan would recognize the appropriate correction as indicated herein. See, *In re Oda*, 443 F.2d 1200, 170 USPQ 268 (CCPA 1971).

These amendments do not add any new matter.

II. Status of the Claims

Claims 33-41, 46, 48-53, 55, 64 and 184 remain pending. Claim 33 is currently amended.

Claim 33 is amended to clarify the recitation of organic molecules having an -NH_2 group whose nitrogen atom forms a bond with M. Specifically, the recitation of “organic molecules having an -NH_2 group whose nitrogen atom forms a bond with M” has been amended to explicitly incorporate the particular organic molecules. Support for this amendment may be found, for example, in paragraphs [0108], [0113], [0114], and [0125] of the specification as published.

No new matter is added.

III. Abstract

The Office Action alleged that the application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). Applicants respectfully disagree. The application was published as U.S. Patent Publication No. 2008/0176940 A1 on July 24, 2008. The publication contains an abstract on the first page.

IV. Response to Rejections Under 35 U.S.C. § 112

Claims 36, 48-53 and 184 are rejected under 35 U.S.C. § 112, second paragraph as allegedly indefinite. Specifically, the Examiner alleges the following:

- 1) Claim 36 is indefinite because the meaning of AMPA is undefined,
- 2) Claim 48 is indefinite because it is not clear how the organic molecule is protected from an enzyme since the claim is directed to preparing a compound of claim 33, and because it is not clear how compounds of claim 33 are prepared when L^2 does not equal L^1 ,
- 3) Claims 49-53 are indefinite because it is not clear how the compound is exposed to light after it is administered to a subject, and
- 4) Claim 184 is not clear as to what effect of the organic molecule on the biological sample is being determined, and because the method for assaying an organic molecule is unclear.

Applicants respectfully submit that one of ordinary skill in the art would have been able to readily understand the meaning of the claims as presented.

Notwithstanding the fact that one of ordinary skill in the art would recognize the meaning of AMPA, the meaning of AMPA can also be recognized in the specification. Specifically, paragraph [0114] recites “tetrazolyl- α -amino-3-hydroxy-5-methyl-4-isoxazolepropionic acid”, which is parenthetically recited as “(tetrazol-5-yl) AMPA.” Thus, the skilled artisan would also recognize from the recitation of paragraph [0114] that AMPA is α -amino-3-hydroxy-5-methyl-4-isoxazolepropionic acid. Paragraph [0114] contains a typographical error in the spelling of this

term, which would (along with the corrected spelling) immediately be recognizable to the skilled artisan as noted previously herein.

Claim 48 is supported, for example, in paragraph [0116], wherein preparation of compounds containing L^2 not equal to L^1 . Furthermore, paragraph [0137] describes, for example, how the molecule is protected from the effect of an enzyme.

Regarding claims 49-53, exposure of the compound to light is described in [0121], [0144]-[0145], [0159] and [0164]. Examples 14 and 16 further show photorelease performed in a cell.

Regarding claim 184, the effects are described, for example, in paragraphs [0198], [0199], and [0201]. For example, paragraph [0199] describes a neuronal response as the effect being determined. Paragraph [0201] describes assessment of neurophysiological activity.

Accordingly, it is respectfully requested that the rejection of claims 36, 48-53 and 184 under 35 U.S.C. § 112, second paragraph as allegedly indefinite be reconsidered and withdrawn.

V. Response to Rejections Under 35 U.S.C. § 102

Claims 33, 41, 46, 48-53, 55, 64 and 184 are rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Griffith et al. (*J. Chem. Soc., Dalton Trans.* 1998, 2819), Mines et al. (*J. Am. Chem. Soc.* 1996, 118, 1961) and Bosnich et al. (*Aust. J. Chem.* 1966, 19, 2229).

Griffith:

The Examiner alleges that the last four complexes in Table 2 of Griffith anticipate the claims when the metal is Ru, variable L^2 represents L^1 and L^1 represents the $-NH_2$ group in claim 33. Claim 33 has been amended to recite specific organic molecules having an $-NH_2$ group. The amino groups in the last four complexes in Table 2 of Griffith are not encompassed by the claims as amended.

Claims 41, 46, 48-53, 55, 64 and 184 are neither anticipated by nor obvious over Griffith. Griffith relates to specific complexes that have been made via catalytic dehydrogenation of benzylic and other amines to the corresponding nitriles. Griffith measured spectral properties of some of these compounds. Griffith does not relate to methods for releasing organic molecules from a photolabile compound comprising exposing compounds to light, methods for protecting an organic molecule from an effect of an enzyme, methods for making a molecule bioavailable, compositions comprising a compound of claim 33, kits comprising a compound of claim 33, or a method for assaying an organic molecule comprising exposing a compound of claim 33 to light.

Mines:

The Examiner alleges that $[\text{Ru}(\text{phen})_2(\text{CN})(\text{im})]\text{Cl}$ as disclosed by Mines anticipates the instant claims when the metal is Ru, L^1 is a 5-membered monocyclic aromatic ring and L^2 is CN in claim 33. Claim 33 has been amended to remove the recitation of L^2 as CN. The compounds in Mines are not encompassed by the claims as amended.

Claims 41, 46, 48-53, 55, 64 and 184 are neither anticipated by nor obvious over Mines. Mines relates to measuring rates of electron transfer reactions in $\text{Ru}(\text{His33})\text{cytochrome c}$ complexes. Mines does not relate to methods for releasing organic molecules from a photolabile compound comprising exposing compounds to light, methods for protecting an organic molecule from an effect of an enzyme, methods for making a molecule bioavailable, compositions comprising a compound of claim 33, kits comprising a compound of claim 33, or a method for assaying an organic molecule comprising exposing a compound of claim 33 to light.

Bosnich:

The Examiner alleges that ruthenium complexes disclosed by Bosnich on page 2233 anticipate the instant claims when the metal is Ru, L^1 is a 6-membered monocyclic aromatic ring and L^2 is either CN or NH_2 in claim 33. Applicants respectfully disagree.

Claims 33, 41, 46, 48-53, 55, 64 and 184 are neither anticipated by nor obvious over Bosnich. Bosnich recites perchlorate salts (ClO_4) of each product on page 2233. Each starting material on page 2233 of Bosnich is a ruthenium complex that contains at least one chlorine atom (Cl) at the position corresponding to L^1 or L^2 in the instant claims. In contrast, the instant claims provide neither for perchlorate salts (variable X cannot be perchlorate) nor for chlorine at either L^1 or L^2 .

Accordingly, it is respectfully requested that the rejection of claims 33, 41, 46, 48-53, 55, 64 and 184 under 35 U.S.C. § 102 as allegedly anticipated by Griffith, Mines and Bosnich be reconsidered and withdrawn.

CONCLUSION

In view of the foregoing remarks and the amendments submitted concurrently herewith, Applicant believes that all of the Examiner's concerns have been addressed. Accordingly, Applicant respectfully requests reconsideration and allowance of the pending claims. If it will facilitate prosecution of this application, the Examiner is invited to contact the undersigned at the telephone number below.

Respectfully submitted,

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